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EXAMINER

ENGLAND, DAVID E

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2143

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12

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/577,909
Filing Date: May 24, 2000
Appellant(s): HALL ET AL.

David England
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/02/2004.

(1) *Real Party in Interest*

Art Unit: 2143

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because the Applicant has arguments in the Summary of Invention where only the summary of the invention should be, i.e. page 4 of Appeal Brief “... *it is not currently possible to attach an entire directory or “folder” to an email note where the folder may contain all the resource files necessary to view the web page.*” Furthermore, the summary of the invention, does not disclose, “... *a mail web page to an email note without being required to first save and attach all of the required files.*” , page 4 of Appeal Brief. In fact the Applicant states on page 10, lines 12 – 15 of the filed application, “*If a user wants to send only the HTML source file 202 via email, the user can simply save the main HTML source file as an HTML formatted document and attached the saved document to an email note.*”.

(6) *Issues*

Art Unit: 2143

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-35 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,163,779

Mantha et al.

12-2000

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 4, 7, 8, 10, 12, 13, 16 – 20, 22 – 24 and 27 – 35 are rejected under 35 U.S.C. 102(e). This rejection is set forth in prior Office Action, Paper No. 6.

Claims 2, 5, 6, 9, 11, 14, 15, 21, 25 and 26 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 6.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application

Art Unit: 2143

filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 7, 8, 10, 12, 13, 16 – 20, 22 – 24 and 27 – 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Mantha et al. U.S. Patent No. 6163779 (hereinafter Mantha).

Referencing claim 10, Mantha teaches a method for automatically attaching a web page as a single file to an email note, the method comprising the steps of:

determining that a user desires to attach a selected file to the email note, (e.g. col. 8, line 1 – col. 9, line 37);

determining whether the selected file is a web page, (e.g. col. 8, line 1 – col. 9, line 37);

in response to a determination that the selected file is a web page, determining whether the selected file includes at least one link to at least one resource file, (e.g. col. 8, line 15 – col. 9, line 14 & col. 10, lines 16 – 39 & col. 11, line 4 – col. 12, line 56); and

in response to a determination that the selected file includes at least one link to at least one resource file, determining whether automatic attachment of the at least one resource file has been authorized, (e.g. col. 11, line 4 – col. 12, line 56 & col. 13, lines 33 - 48); and

in response to a determination that automatic attachment of the at least one resource file has been authorized, packaging the selected file and the at least one resource file into a single attachment file and attaching the attachment file to the email note, (e.g. col. 8, line 15 – col. 9, line 14 & col. 13, lines 33 - 48).

Art Unit: 2143

Referencing claim 12, Mantha teaches the step of determining that a user desires to attach a file to the email note comprises determining that a user has inserted the selected file into the email note, (e.g. col. 11, line 4 – col. 12, line 56 & col. 13, lines 33 - 48).

Referencing claim 13, Mantha teaches the step of determining that a user desires to attach a file to the email note comprises determining that a user has copied the selected file into the email note, (e.g. col. 11, line 4 – col. 12, line 56 & col. 13, lines 33 - 48).

Referencing claim 16, Mantha teaches the step of determining that the selected file includes at least one link to at least one resource file comprises determining whether the selected file includes a tag including the string: <link rel=FileList href=>, (e.g. col. 10, line 16 – col. 12, line 35).

Referencing claim 17, Mantha teaches the step of determining that the selected file includes at least one link to at least one resource file comprises determining whether the selected file includes a link tag selected from the group of:

;

;

;

<body background=>;

<script src=>;

<bgsound src=>;

Art Unit: 2143

<embed src=>; and

<link rel="stylesheet">, (e.g. col. 9, line 50 – col. 12, line 35).

Referencing claim 18, Mantha teaches the step of determining whether automatic attachment of the at least one resource file has been authorized comprises determining the status of at least one registry key, (e.g. col. 10, line 16 – col. 12, line 47 & col. 13, lines 33 – 48).

Referencing claim 19, Mantha teaches the step of determining the status of at least one registry key comprises determining the status of a web page packing registry key, (e.g. col. 10, line 16 – col. 12, line 47 & col. 13, lines 33 – 48).

Referencing claim 20, Mantha the step of determining the status of at least one registry key comprises determining the status of an automatic packing registry key, (e.g. col. 10, line 16 – col. 12, line 47 & col. 13, lines 33 – 48).

Referencing claim 30, Mantha teaches determining whether automatic attachment of resource files for the web page has been authorized, (e.g. col. 8, line 15 – col. 9, line 14 & col. 13, lines 33 – 48).

Claims 1, 3, 4, 7, 8, 22 – 24, 27 – 29 and 31 – 35 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

Art Unit: 2143

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 11, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mantha (6163779) in view of Borman et al. (6226655) (hereinafter Borman).

As per claim 11, Mantha does not specifically teach the step of determining that a user desires to attach a file to the email note comprises determining that a user has dragged the selected file into the email note. Borman teaches the step of determining that a user desires to attach a file to the email note comprises determining that a user has dragged the selected file into the email note, (e.g. col. 12, line 62 – col. 13, line 17). It would have been obvious to one skilled in the art at the time the invention was made to combine Borman with Mantha because it would be more convenient for a user to utilize a common function, (i.e. “drag & drop”), to copy or relocate a file as apposed to typing a command to do the same function, (i.e. using a DOS prompt).

Claims 2 and 26 are rejected for similar reasons as stated above.

Claims 5, 6, 14, 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mantha (6163779) in view of Gupta et al. (6519646) (hereinafter Gupta).

Art Unit: 2143

As per claim 14, Mantha does not specifically teach the step of determining that the selected file is a web page comprises determining whether the selected file has an ".htm" extension. Gupta teaches the step of determining that the selected file is a web page comprises determining whether the selected file has an ".htm" extension, (e.g. col. 4, lines 45 – 59). It would have been obvious to one skilled in the art at the time the invention was made to combine Gupta with Mantha because it would be more efficient for a system to know the difference between a web page file that could be a potential link to another web page or an object that is just a picture or a link to another part of the web page that does not take a user to a different web page file. This could be used to save different parts of a web page in different directories/ folders.

As per claim 15, Mantha does not specifically teach the step of determining that the selected file is a web page comprises determining whether the selected file has an ".html" extension. Gupta teaches the step of determining that the selected file is a web page comprises determining whether the selected file has an ".html" extension, (e.g. col. 4, lines 45 – 59). It would have been obvious to one skilled in the art at the time the invention was made to combine Borman with Mantha because of similar reasons as stated above.

Claims 5 and 6 are rejected for similar reasons as stated above.

Claims 9, 21, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mantha (6163779) in view of Gabbard et al. (6205432) (hereinafter Gabbard).

Art Unit: 2143

As per claim 21, Mantha teaches all that is similar and described above but does not specifically teach converting the selected file and the at least one resource file into an MHTML file. Gabbard teaches converting the selected file and the at least one resource file into an MHTML file, (e.g. col. 11, line 65 – col. 13, line 17). It would have been obvious to one skilled in the art at the time the invention was made to combine Gabbard with Mantha because it would be more efficient for a system to utilize a common protocol such as Multipurpose Internet Mail Extensions HTML, (i.e. MINE-HTML or MHTML). This protocol enables the system to more efficiently send and receive graphics, audio, and video files via the Internet mail system. Furthermore, MIME was defined in 1992 by the IETF.

Claims 9 and 25 are rejected for similar reasons as stated above.

Response to Arguments

Applicant's arguments filed 07/23/2003 have been fully considered but they are not persuasive.

In the remarks, Applicant argued in substance that states Mantha does not teach packing of a single attachment file containing the web page file and its resource files; packing only occurs in response to the determination that the selected file has at least one link to a resource file and to the determination that the selected file is a web page; another determination in the combination of determinations is a determination that the attachment of the resource file is authorized.

Art Unit: 2143

As to part 1, Examiner would like to draw the Applicant's attention to the restated rejection filed 04/23/2003 and the further citing of the presented prior art that should clarify the teachings of Mantha. In the above-cited reference of claim 10, Mantha teaches packing of a single attachment file containing the web page file and its resource files. Quoting Mantha, "The file directory (for the copied pages (e.g. c:\user\copies\c1\c1.htm, i1.jpg, etc.)) is self-contained and needs no other files or system dependent information to view the copied page. As a result, the invention may be used with an e-mail application to simplify the transfer of the saved Web page. In particular, the user simply attaches a copy of the directory contents to the e-mail and all embedded files get transferred." This is found in column 13, lines 40 – 47 in Mantha. If the Applicant would look at the example they would notice that it is one directory with multiple resource files in the directory. Further proof of this can be found in the cited areas stated the rejection of claim 10. Mantha also teaches packing only occurs in response to the determination that the selected file has at least one link to a resource file and to the determination that the selected file is a web page, and a determination that the attachment of the resource file is authorized, as restated above and further clarified. To quote Mantha, "The box also includes a Type request field that is clicked by the user to indicate that a "copy of a page" is desired." "At step 35, the user clicks DONE to initiate the copy (e.g. col. 8, lines 56 – 61). Linked list 74 (LL1) is a linked list of URLs in the original file, and this list is preferably created in the order of the links as they appear from the beginning of the file, (e.g. col. 10, lines 22 – 25). Each entry of the first linked list is preferably added to a back of the list. Thereafter, and for each hypertext reference in the first linked list, the following operations are performed. If the hypertext reference refers to an embedded object in the base HTML document, the embedded object is saved on the client local

Art Unit: 2143

storage and the file name of the saved embedded object is stored (as a fully-qualified URL) in a second linked list, (e.g. col. 12, lines 15 – 22).” Mantha does teach authenticating the files and determining that the selected file is a web page with at least one link.

Other areas of the cited reference can also clarify the limitations stated above. Furthermore, these quoted sections should not in any way hinder the prior art in just these areas since these cited areas are just a sample of the areas that are referred to in the action.

In the remarks, Applicant argued in substance that states Mantha does not teach packing a web page and a resource file into a single file or, in this particular case, a single web archive file.

As to part 2, the Examiner would like to draw the Applicant’s attention to part 1 of the response to arguments, where it is stated above that Mantha does teach packing a web page and a resource file into a single file or, in this particular case, a single web archive file.

In the remarks, Applicant argued in substance that states Borman does not fill any of the deficiencies discussed above regarding the Mantha reference relative to claim 1.

As to part 3, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Art Unit: 2143

In the remarks, Applicant argued in substance that states Gupta does not satisfy any of the deficiencies of the Mantha reference as discussed above for claim 1.

As to part 4, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the remarks, Applicant argued in substance that states Gabbard does not teach packing a web page and all of its resource files into a single attachment file.

As to part 4, Examiner would like to draw the Applicant's attention to the independent claims of the application and the cited rejections that are associated in the independent claims. Mantha teaches this deficiency as stated and restated above and therefore are still covered in the dependent claims that rely on the independent claims of the application. The reference of Gabbard was to address the lacking limitation of converting the files and the at least one resource file into an MHTML file which is stated above and further clarified by the Examiner as to the specific limitation Gabbard teaches.

(11) Response to Argument

In the arguments, Applicant states in substance that Mantha does not describe packing these separate and distinct files into a **single file** as recited in the pending claims. Furthermore, Mantha et al. does not disclose or suggest automatically packing or attaching such files to an

Art Unit: 2143

email note in response to a user's request to attach the main web page (i.e., the base HTML document) to the email note.

As to the first argument, the Examiner would like to draw the Applicant's attention to column 13, lines 39 – 48 of the cited prior art of Mantha et al. U.S. Patent No. 6163779 (hereinafter Mantha). In this column it is stated, "*The file directory (for the copied pages (e.g.c:\user\copies\c1\c1.htm, i1.jpg, etc.)) is self-contained and needs no other files and system dependent information to view the copied page. As a result, the invention may be used with an e-mail application to simplify the transfer of the saved Web page. In particular, the user simply attaches a copy of the directory contents to the e-mail and all embedded files get transferred. This is a simple and efficient means of e-mailing a Web page.*".

Note that the file directory is self-contained and need no other files. Having a file, such as a type of directory, being self-contained would mean that there **is only one file that has all the files** it needs to view the web page. Therefore, having the all the files in the file directory, which is a type of file, and having said file directory being self-contained, would read on the claim language of "packing these separate and distinct files into a **single file** as recited in the pending claims".

As for Mantha not disclosing or suggesting automatically packing or attaching such files to an email note in response to a user's request to attaching the main web page (i.e., the base HTML document) to the email note. The Examiner would like to point out that the above statement is not specifically disclosed in the claim language of this application. The closes interpretation of the claim language that the above statement can be found is in the preamble of

Art Unit: 2143

claims 1, 10, 22 and 29 which states, "*A method/system for automatically attaching a web page as a single file to an email note...*". In response to applicant's arguments, the recitation "*A method/system for automatically attaching a web page as a single file to an email note...*" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Furthermore, Mantha teaches when a web page is saved all of the documents and objects associated with the web page, are save with it in a file directory. Therefore, the user does not have to save individual objects in the web page, the system "automatically" associates all the objects as belonging to the main web page, (e.g. Abstract & col. 2, lines 8 – 14, "*The preferred solution is to save a copy of the HTML base document and each of its embedded objects (e.g., image files, sound files and/or video files) on a client hard drive*" & col. 13, lines 32 – 48, "*...the user simply attaches a copy of the directory contents to the e-mail and all embedded files get transferred.*"). In the application, (page 13, lines 12 – 30), discloses, "*The email client will detect an attachment event when the user attempts to attach or enclose a file with the email note. Examples of attachment events include: (1) the user dragging one or more files to an email note from another location; (2) a user choosing "Insert File" and inserting one or more tiles into an email note; and (3) a user copying one or more files from some location and pasting them into an email note.*" This example stated by the Applicant would leave one to believe that when a

Art Unit: 2143

user copies a web page file to an email note, all the files associated with the web page are placed in the email note in one file “automatically”. The above cited areas of Mantha read on this interpretation and the claim language as broadly interpreted by the Examiner.

The Applicant also argues that, “Mantha does not describe or suggest attaching the entire directory to an email note. Indeed, as noted above and as described in the Background section of the present application, it is not currently possible to attach an entire directory or “folder” to an email note where the folder may contain all the resource files necessary to view the web page.”

As stated above by the Examiner, Mantha does teach every embedded file of the web page is transferred to the email note. The Examiner would like to remind the Applicant of the quoted areas of reference in Mantha, (e.g. Abstract & col. 2, lines 8 – 14 & col. 13, lines 32 – 48), in which reads on the claim language as stated by the Applicant. As for the Applicant’s Background of the invention, that is solely based on Applicant’s experience and research, and has no weight on the invention or the reference because it has been documented that Mantha invention is unique and is therefore granted a patent number. Furthermore, Applicant later states that Mantha’s invention teaches, “In sum, Mantha et al. describes the basic invention of saving a web page to a local drive for later viewing, Mantha further recognizes that once the web page has been saved in a single directory it is possible to attach all of the files within the directory to an email for transfer to another user.” This contradicts what the Applicant states above in their arguments.

Applicant further argues that Mantha et al. does not describe the presently claimed invention where a user who desires to send a web page to an email recipient simply elects to attach or “drag” the main web page to an email not while the steps of scanning the web page for resource files and packing all the associated files into a single file for attachment to the email not occur “in the background”.

As to the above argument, Mantha does teach where a user who desires to send a web page to an email recipient simply elects to attach the file with all the embedded files associated with it as discussed in the previous arguments, (e.g. col. 13, lines 39 – 48, “*The file directory (for the copied pages (e.g.c:\user\copies\c1\c1.htm, i1.jpg, etc.)) is self-contained and needs no other files and system dependent information to view the copied page. “The file directory (for the copied pages (e.g.c:\user\copies\c1\c1.htm, i1.jpg, etc.)) is self-contained and needs no other files and system dependent information to view the copied page. As a result, the invention may be used with an e-mail application to simplify the transfer of the saved Web page. In particular, the user simply attaches a copy of the directory contents to the e-mail and all embedded files get transferred. This is a simple and efficient means of e-mailing a Web page.”*). As for the Applicant arguing packing all the associated files into a single file for attachment to the email note occurring “in the background”, this is not disclosed in the claim language and therefore has not patentable weight with this argument.

Applicant further argues that Mantha does not teach or suggest automatically attaching all the necessary files to an email in response to a user’s request to email only the main HTML page.

The above argument, “*automatically attaching all the necessary files to an email in response to a user’s request to email only the main HTML page*,” (emphasis added), is not specifically described in the claim language and therefore has no weight in this argument.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

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